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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/753,874	01/09/2004	Hans Joachim Halamoda	7863-80940	6117
7590 08/12/2004			EXAMINER	
Norman N. Kunitz FITCH, EVEN, TABIN & FLANNERY Suite 401L 1801 K Street N.W. Washington, DC 20006			NGUYEN, PHONG H	
			ART UNIT	PAPER NUMBER
			3724	

DATE MAILED: 08/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/753,874	Applicant(s) HALAMODA ET AL.	
	Examiner Phong H Nguyen	Art Unit 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, lines 5 and 7, it is unclear at least one punched hole or a plurality of punched holes is claimed. It is assumed that at least one punched hole is claimed.

Claim 2 recites the limitation "the transverse direction" in lines 2 and 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 8 is unclear.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3 and 5-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Wilson (4,092,888).

It is noted that claim 1 does not have traditional transitional phrase such as “comprising” or “including” and the last two sub-paragraphs are not joined by the word “and”. It is assumed that the word “comprising” is used in the preamble.

Regarding claim 1, Wilson teaches punching device capable of punching holes on a ceramic substrate comprising:

a receiving device 11, which has a substantially flat receiving face for a ceramic substrate (W), and in which a punched hole 12 is embodied;  
at least one die, which disposed above a punched hole 12 and has a shaft and an operative portion that extends through a stripper opening 32 and whose diameter is less than the diameter of the shaft and greater than the diameter of an associated punched hole 12, and the operative portion has a punching portion whose diameter is somewhat less than the diameter of the punched hole

a drive mechanism 15, which is connected in driving fashion to the die in order to move linearly by a defined stroke and in the process to move the punching portion into the punched hole and out of it, and

a die guide device 13, through which the shaft extends and which guides the die at its shaft (15). See Figs. 1 and 5

Regarding claim 2, the punching portion is unguided in the transverse direction. It is guided in the longitudinal direction. See Figs. 1 and 5.

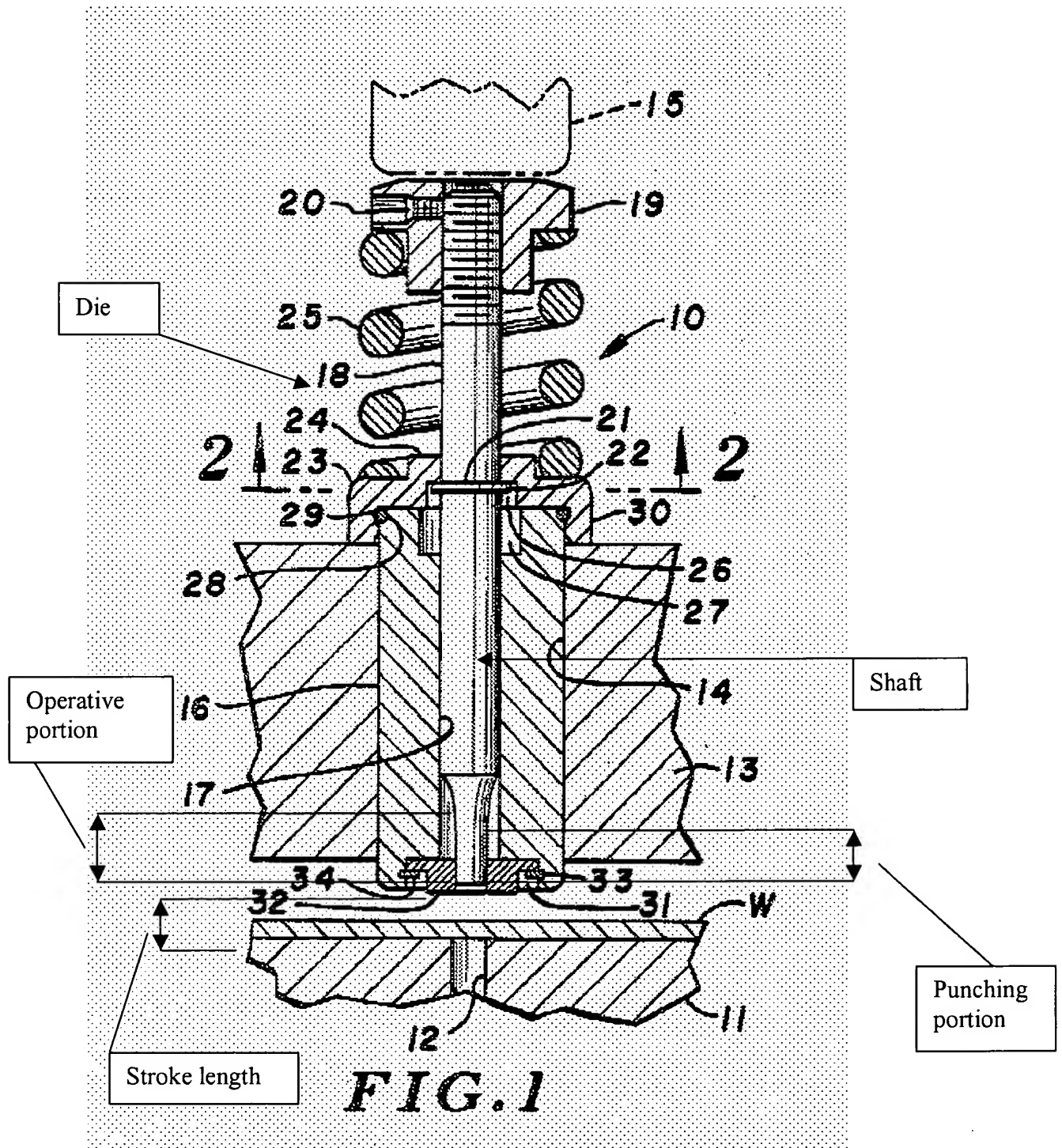
Regarding claim 3, the guide device 13 having a bush 16 with a passage 17 is best seen in Figs. 1 and 5.

Regarding claim 5, it appears the length of the punching portion is equal to the length of the stroke of the drive mechanism. See Fig. 1.

Regarding claim 6, it appears that the length of the operative portion is greater the stroke of the drive mechanism. See Figs. 1 and 5.

Regarding claim 7, the punched hole 12 is best seen in Figs. 1 and 5.

Regarding claim 8, the allowability cannot be commented on at this time in view of the issues under 35 USC 112. However, the next Office Action is intended to be a Final Action if prior art is determined to be applicable upon compliance with 35 USC 112.



***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson (4,092,888) in view of Kanawaza et al. (5,600,992).

Wilson teaches the invention substantially as claimed except for the length of the stripper opening. Kanawaza et al. teach providing a stripper 45 having a length that exceeding the length of a punching portion 46. See Figs. 3 and 4. Therefore, it would have been obvious to one skilled in the art to provide a stripper having a length that exceeding the length of a punching portion as taught by Kanawaza et al. to the punching assembly of Wilson as an alternative combination of a stripper and a punching portion.

7. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson (4,092,888).

Wilson teaches the invention substantially as claimed except for the relative stroke's length of the driving mechanism with respect to the operative portion and the punching portion. One skilled in the art would have been motivated to adjust the stroke's length with respect to the length of the operative portion and the punching portion so that they can penetrate through a work piece.

***Conclusion***

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8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Weisbeck (4,141,264), Grabbee (5,448,933), Bennett (4,951,537) and Hugo (4,246,815) teach punching assembly of general interest.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phong H Nguyen whose telephone number is 703-305-4989. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 703-308-1082. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PN:



August 6, 2004



Allan N. Shoap  
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